

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Hedrick et al.

Attorney Docket No.:
IGT1P006C1R1/P-161 A CON R1

Application No.: 10/817,625

Examiner: Benjamin Layno

Filed: April 1, 2004

Group: 3711

Title: GAMING MACHINE HAVING
SECONDARY DISPLAY FOR PROVIDING
VIDEO CONTENT

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as first-class mail on November 21, 2006 in an envelope addressed to the Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450.

Signed: _____

Chereyce Brown
Chereyce Brown

PETITION FOR APPLICATION BY OTHER THAN ALL THE INVENTORS
Pursuant to 37 C.F.R. §1.47 (a)

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants Joseph R. Hedrick, Jean Pierre Legras, Chauncey W. Griswold and Don C. Stephan (the "remaining joint inventors") hereby petition the Commissioner to accept for application the above-identified U.S. Patent Application by other than all of the inventors.

The above-referenced application names four (5) inventors: Joseph R. Hedrick, Robert A. Luciano, Jr., Jean Pierre Legras, Chauncey W. Griswold and Don C. Stephan. The joint inventors Joseph R. Hedrick, Jean Pierre Legras, Chauncey W. Griswold and Don C. Stephan have executed the application, however, Mr. Luciano, Jr. has refused to execute the application.

Filed herewith in response to the Office Action is the Patent Supplemental Declaration of the signing inventors with the signature block of the non-signing inventor, Mr. Luciano, Jr., left blank. In accordance with M.P.E.P. §409.09(a), it is respectfully submitted that this Declaration may be treated as having been signed by the remaining joint inventors, on behalf of the non-signing inventor, Mr. Luciano, Jr.

A Declaration of Facts in Support of Applying on Behalf of Omitted Inventors is also attached hereto and provides proof of the pertinent facts regarding the omitted inventor who refused to sign as required by 37 C.F.R. §1.47(a) and M.P.E.P. §409.03(d).

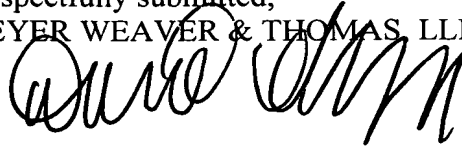
11/28/2006 EAYALEW1 00000022 500388 10817625

01 FC:1463 200.00 DA

BEST AVAILABLE COPY

In view of the refusal of the omitted inventor to sign the papers required for the above-identified application, the remaining joint inventors are believed to be entitled to make such an application on behalf of and as agents for the omitted inventors. The required fee pursuant to 37 C.F.R. §1.17(i) is enclosed.

Respectfully submitted,
BEYER WEAVER & THOMAS, LLP

A handwritten signature in black ink, appearing to read 'David P. Olynick', is written over the printed name.

David P. Olynick
Registration No. 48,615

P.O. Box 70250
Oakland, CA 94612-0250
(510) 663-1100



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Hedrick et al.

Application No.: 10/817,625

Filed: April 1, 2004

Title: GAMING MACHINE HAVING
SECONDARY DISPLAY FOR PROVIDING
VIDEO CONTENT

Attorney Docket No.:

IGT1P006C1R1/P-161 A CON R1

Examiner: Benjamin Layno

Group: 3711

**DECLARATION OF FACTS IN SUPPORT OF APPLYING ON BEHALF OF OMITTED
INVENTORS**

Pursuant to 37 C.F.R. §1.47 (a)

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

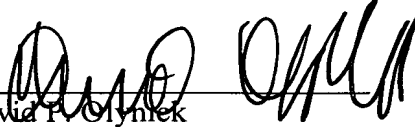
Dear Sir:

This declaration is made as to the facts that are relied upon to establish the *bona fide* effort made to secure the execution of the Supplemental Declaration for the above-identified patent application by the nonsigning inventor, Robert A. Luciano, Jr.. This declaration is being made by the available person having first-hand knowledge of the facts recited therein.

I, David P. Olynick, do hereby declare:

1. I am a patent agent involved in the preparation of the above referenced application. The application names five inventors, Joseph R. Hedrick, Robert A. Luciano, Jr., Jean Pierre Legras, Chauncey W. Griswold, and Don C. Stephan. All were employed by and/or under an obligation to assign the invention to IGT at the time the invention of the subject application was made.
2. An Office Action was mailed on May 26, 2006 requesting that the applicant submit a supplemental declaration prior to allowance.

3. On June 13, 2006, my assistant, Chereyce Brown, sent a Supplemental Declaration for U.S. Reissue Patent Application ("Declaration") to Kimberley A. DiMino, Trademark and Legal Administration Manager at IGT, by email requesting that she have each of the inventors sign the Declaration for filing with U.S. Patent Office. A copy of the email dated June 13, 2006, is attached as Exhibit A.
4. On July 12, 2006, Kimberley A. DiMino, sent a Supplemental Declaration for U.S. Reissue Patent Application ("Declaration") and a copy of the allowed claims to Robert Luciano, Jr. and Lars Perry, Esq., Vice President of Intellectual Property at Bally Gaming and Systems, by Certified Mail requesting that Mr. Luciano ("Bob") sign and date the Declaration. A copy of the cover letter dated July 12, 2006 and return receipts for both Mr. Lars and Mr. Luciano dated July 13, 2006 is attached as Exhibit B.
5. On August 8, 2006, Ms. DiMino sent Mr. Lars an email inquiring about the status of Mr. Luciano signing the Declaration. A copy of Ms. DiMino's email with a response from Mr. Lars is attached as Exhibit C.
6. On August 9, 2006, Mr. Luciano sent Ms. DiMino a letter requesting a copy of the file wrapper of the original and reissue applications before he would consider signing the Declaration. A copy of Mr. Luciano's letter is attached as Exhibit D.
7. On August 22, 2006, Ms. DiMino sent a letter to Mr. Luciano, by Certified Mail outlining instructions on how to access the electronic file wrappers on the USPTO public PAIR website. Ms. DiMino also requested that Mr. Luciano respond by September 22, 2006. A copy of Ms. DiMino's letter is attached as Exhibit E.
8. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.


David P. Glynnek
Registration No.: 48,615
Nov. 21 2006
Date



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Hedrick et al.

Attorney Docket No.:
IGT1P006C1R1/P-161A CON R1

Patent No.: 6,368,216

Issued: April 9, 2002

Title: GAMING MACHINE HAVING
SECONDARY DISPLAY FOR PROVIDING
VIDEO CONTENT

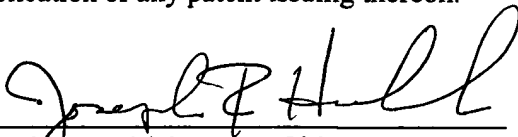
Mail Stop Reissue
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REISSUE APPLICATION DECLARATION BY INVENTORS

As a below-named inventor, I hereby declare that:

1. Every error in the patent which was corrected in the present reissue application, and which is not covered by the prior oath(s) and/or declaration(s) submitted in this application, arose without any deceptive intention on the part of the applicant.

We hereby declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.


Joseph R. Hedrick -- U.S. Citizen

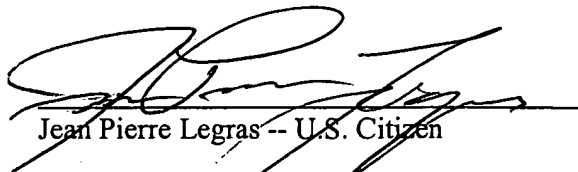
Date: 7-20-06

Mailing Address and Resident:
13355 W. Saddlebow Drive
Reno, Nevada 89511

Robert A. Luciano, Jr. -- U.S. Citizen

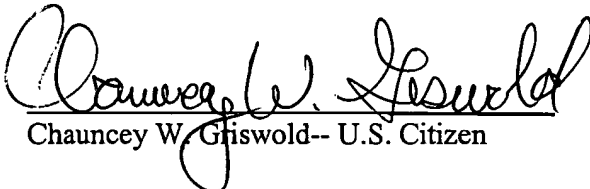
Date: _____

Mailing Address and Residence:
4665 Lakewood Court
Reno, Nevada 89509


Jean Pierre Legras -- U.S. Citizen

Date: 7/21/06

Mailing Address and Residence:
10590 Crystal Bay Drive
Reno, NV 89521


Chauncey W. Griswold -- U.S. Citizen

Date: 7-15-06

Mailing Address and Residence:
1160 Monroe Court
Reno, NV 89509

Don C. Stephan-- U.S. Citizen

Date: _____

Mailing Address and Residence:
305 Viola Way
Carson City, NV 89704

Robert A. Luciano, Jr. -- U.S. Citizen

Date: _____

Mailing Address and Residence:
4665 Lakewood Court
Reno, Nevada 89509

Jean Pierre Legras -- U.S. Citizen

Date: _____

Mailing Address and Residence:
10590 Crystal Bay Drive
Reno, NV 89521

Chauncey W. Griswold-- U.S. Citizen

Date: _____

Mailing Address and Residence:
1160 Monroe Court
Reno, NV 89509



Don C. Stephan-- U.S. Citizen

Date: 7/31/06

Mailing Address and Residence:
305 Viola Way
Carson City, NV 89704

EXHIBIT A

From: Chereyce Brown
To: Dimino.Kimberley.A
Date: 6/13/2006 1:38:57 PM
Subject: RE: Secondary Display Reissue claims allowed (P161-A CON R1)

Kimberley-

Thanks for getting back to me with Don Stephan's zip code. Attached is the Supplemental Declaration for the above-referenced case. Please have the inventors sign the Declaration and return it to us as soon as possible.

Best,
Chereyce

Chereyce Brown
Patent Secretary
Beyer Weaver & Thomas, LLP
500 12th Street, Suite 200
Oakland, CA 94607
(510) 663-1100
cbrown@beyerlaw.com

=====
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>>> "Dimino.Kimberley.A" <Kimberley.Dimino@igt.com> 6/13/2006 11:57 AM >>>
Chereyce,

As far as I can tell these are correct, and Don Stephans zip code is 89704. Thank you.

Kimberley

Kimberley A. DiMino
Trademark and Legal Administration
Manager, Intellectual Property Department
IGT
9295 Prototype Drive
Reno, Nevada 89521-8986
Office: (775) 448-1438
Fax: (775) 448-7780
Email: Kimberley.Dimino@IGT.Com

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EXHIBIT B



July 12, 2006

VIA CERTIFIED MAIL
RETURN RECEIPT REQUESTED

Lars Perry, Esq.
Vice President Intellectual Property
Bally Gaming and Systems
950 Sandhill Road
Reno, Nevada 89521

VIA CERTIFIED MAIL
RETURN RECEIPT REQUESTED

Robert Luciano, Jr.
Bally Gaming and Systems
300 Sierra Manor Drive
Reno, Nevada 89511

Re: Supplemental Reissue Declaration By Inventors
Inventors: Hedrick, et al.
Entitled: Gaming Machine Having Secondary Display Providing Video Content

Dear Lars and Bob:

I am enclosing an original Reissue Application Declaration By Inventors for Bob's signature, regarding the above-entitled matter. I have also enclosed a copy of the allowed claims for your review and reference. Once you have had a chance to review the Declaration, please have Bob execute and date where indicated. Once the Declaration has been executed, please give me a call at (775) 448-1438, and I will have the documents picked up in order to expedite further processing of this document with the other inventors. I thank you so much for your help in obtaining Bob's signature on this document.

Should you have questions or comments, please do not hesitate to contact Keith Moore, Intellectual Property Attorney at (775) 448-1174 or myself at (775) 448-1438 to discuss.

Very truly yours,

A handwritten signature in dark ink, appearing to read "Kimberley A. DiMino", is written over the typed name.

Kimberley A. DiMino
Trademark and Legal Administration
Manager, Intellectual Property Department

/kad

Enclosures

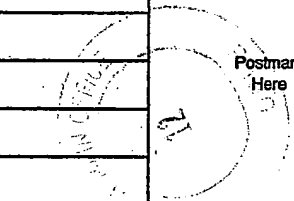
cc: Keith Moore, Esq.

International Game Technology

9295 Prototype Drive
Reno, NV 89521-8986
775-448-7777
www.IGT.com

7004 1350 0003 7927 2569

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Total Postage & Fees	\$
Sent To IARS PERRY, ESO, BALLY GAMING SYSTEMS Street, Apt. No., or PO Box No. 950 Sandhill Road City, State, ZIP+4® RENO, NV 89521 ATTN: KIMBERLEY LEGAL DEPT.	
PS Form 3800, June 2002 See Reverse for Instructions	



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- For an additional fee, a *Return Receipt* may be requested to provide proof of delivery. To obtain Return Receipt service, please complete and attach a Return Receipt (PS Form 3811) to the article and add applicable postage to cover the fee. Endorse mailpiece "Return Receipt Requested". To receive a fee waiver for a duplicate return receipt, a USPS® postmark on your Certified Mail receipt is required.
- For an additional fee, delivery may be restricted to the addressee or addressee's authorized agent. Advise the clerk or mark the mailpiece with the endorsement "*Restricted Delivery*".
- If a postmark on the Certified Mail receipt is desired, please present the article at the post office for postmarking. If a postmark on the Certified Mail receipt is not needed, detach and affix label with postage and mail.

IMPORTANT: Save this receipt and present it when making an inquiry. Internet access to delivery information is not available on mail addressed to APOs and FPOs.

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- Complete items 1, 2, and 3. Also complete item 4 if Restricted Delivery is desired.
- Print your name and address on the reverse so that we can return the card to you.
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1. Article Addressed to:

Lars Perry, Esq.
Vice President Intellectual Prop
Bally Gaming and Systems
950 Sandhill Road
Reno, NV 89521

COMPLETE THIS SECTION ON DELIVERY

A. Signature

X*L. Carter*☐ Agent☐ Addressee

B. Received by (Printed Name)

R. CARTER

C. Date of Delivery

7-13-06

D. Is delivery address different from item 1?

☐ Yes

If YES, enter delivery address below:

☒ No

3. Service Type

☒ Certified Mail☐ Express Mail☐ Registered☒ Return Receipt for Merchandise☐ Insured Mail☐ C.O.D.

4. Restricted Delivery? (Extra Fee)

☐ Yes

2. Article Number

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70041350000379272569

UNITED STATES POSTAL SERVICE



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KIMBERLEY A. DIMINO
TRADEMARK AND LEGAL ADMINISTRATION MANAGER
INTELLECTUAL PROPERT DEPT.
IGT
9295 Prototype Drive
Reno, NV 89521-8986

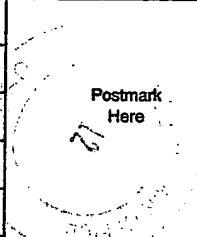
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Return Receipt Fee (Endorsement Required)	
Restricted Delivery Fee (Endorsement Required)	
Total Postage & Fees	\$



Sent To
ROBERT LUCIANO, BALLY GAMING AND SYST.
Street, Apt. No., or PO Box No. **300 Sierra Manor Dr.**
City, State, ZIP+4 **Reno, NV 89511**
ATTN: KIMBERLEY LEGAL DEPT.

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- A mailing receipt
- A unique identifier for your mailpiece
- A record of delivery kept by the Postal Service for two years

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- **NO INSURANCE COVERAGE IS PROVIDED** with Certified Mail. For valuables, please consider Insured or Registered Mail.
- For an additional fee, a *Return Receipt* may be requested to provide proof of delivery. To obtain Return Receipt service, please complete and attach a Return Receipt (PS Form 3811) to the article and add applicable postage to cover the fee. Endorse mailpiece "Return Receipt Requested". To receive a fee waiver for a duplicate return receipt, a USPS® postmark on your Certified Mail receipt is required.
- For an additional fee, delivery may be restricted to the addressee or addressee's authorized agent. Advise the clerk or mark the mailpiece with the endorsement "*Restricted Delivery*".
- If a postmark on the Certified Mail receipt is desired, please present the article at the post office for postmarking. If a postmark on the Certified Mail receipt is not needed, detach and affix label with postage and mail.

IMPORTANT: Save this receipt and present it when making an inquiry.
Internet access to delivery information is not available on mail addressed to APOs and FPOs.

SENDER: COMPLETE THIS SECTION

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- Print your name and address on the reverse so that we can return the card to you.
- Attach this card to the back of the mailpiece, or on the front if space permits.

1. Article Addressed to:

Robert Luciano, Jr.
Bally Gaming and Systems
300 Sierra Manor Drive
Reno, NV 89511

2. Article Number

(Transfer from service label)

70041350000379272552

COMPLETE THIS SECTION ON DELIVERY**A. Signature**

X

Terry Fletcher

☐ Agent

☐ Addressee

B. Received by (Printed Name)

Terry Fletcher

C. Date of Delivery

2/13

D. Is delivery address different from item 1?

☐ Yes

If YES, enter delivery address below:

☒ No

3. Service Type

☒ Certified Mail

☐ Express Mail

☐ Registered

☒ Return Receipt for Merchandise

☐ Insured Mail

☐ C.O.D.

4. Restricted Delivery? (Extra Fee)

☐ Yes

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Kimberley A. DiMino
Trademark and Legal Administration
Manager, Intellectual Property Dept.
IGT
9295 Prototype Drive
Reno, NV 89521-8986

EXHIBIT C

Dimino.Kimberley.A

From: Perry, Lars [LPerry@ballytech.com]
Sent: Tuesday, August 08, 2006 3:04 PM
To: Dimino.Kimberley.A
Subject: RE: Reissue Declaration Document

Kimberley: Bob has prepared a response and should be getting it to you soon... Lars

From: Dimino.Kimberley.A [mailto:Kimberley.Dimino@IGT.com]
Sent: Tuesday, August 08, 2006 10:44 AM
To: Perry, Lars
Cc: Moore.Keith
Subject: Reissue Declaration Document
Importance: High

Mr. Perry,

I met with Keith Moore this morning, and he asked me to follow up with you on your conversation of last week regarding the status of Mr. Luciano executing the above-document. Please advise as to whether or not Mr. Luciano will be executing the Reissue Application Declaration, which was sent to each of you via Certified Mail on July 12, 2006. I look forward to hearing from you. Thank you.

Kimberley

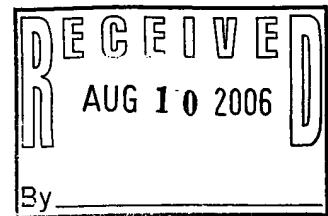
Kimberley A. DiMino
Trademark and Legal Administration
Manager, Intellectual Property Department
IGT
9295 Prototype Drive
Reno, Nevada 89521-8986
Office: (775) 448-1438
Fax: (775) 448-7780
Email: Kimberley.Dimino@IGT.Com

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8/8/2006

EXHIBIT D

August 9, 2006



**Kimberley A. DiMino,
Trademark and Legal Administration
International Game Technology
9295 Prototype Drive
Reno, NV 89521-8986**

**Re: Supplemental Reissue Declaration by Inventors
Gaming Machine Having Secondary Display Providing Video Content**

Dear Kimberley,

Responsive to your letter requesting a supplemental declaration on the above-referenced case, I am requesting that you send a complete copy of the file wrapper of the original application and reissue application in order to give this matter proper consideration.

In order to fulfill my obligation to the U.S. Patent & Trademark Office, 37 CFR 1.63 states that I must believe that I am the original and first inventor of the subject matter which is claimed, that I have reviewed and understand the contents of the application, including the claims, as amended by any amendment, and that I acknowledge the duty to disclose to the Office all information known to me to be material to patentability.

As I am unfamiliar with the application and the contents of the filewrapper, I am presently unable to comply with your request and fulfill my obligations the U.S. Patent & Trademark Office. Should you wish to provide me with the complete filewrapper as I have requested above, I shall endeavor to review the materials at my earliest convenience and give consideration to your request.

Sincerely,

A handwritten signature in black ink, appearing to read "Robert Luciano, Jr.", written over the word "Sincerely,".

**Robert Luciano, Jr.
Bally Technologies
950 Sandhill Rd.
Reno, Nevada 89521**

**Cc: Lars Perry, Esq.
JP Cody, Esq.**



EXHIBIT E

August 22, 2006

VIA CERTIFIED MAIL
RETURN RECEIPT REQUESTED

Robert Luciano, Jr.
Bally Technologies
950 Sandhill Road
Reno, Nevada 89521

Re: Supplemental Reissue Declaration By Inventors
Inventors: Hedrick, et al.
Entitled: Gaming Machine Having Secondary Display Providing Video Content

Dear Bob,

Thank you for your letter dated August 9, 2006. In your letter, you mentioned you needed additional information to comply with your duty under 37 CFR 1.63, and requested copies of the file wrapper of the original application and the reissue application. The electronic file wrappers for the original application and the reissue application are publicly available on the USPTO website using the public PAIR system. The portal web address is "<http://portal.uspto.gov/external/portal/pair>". To access the file wrappers on the web-site, you only need to provide the patent number of the original application (6,368,216) or the application number of the reissue application (10/817,625). We believe using the public PAIR system is quite easy, but if you should have any difficulties, please call us and we can provide you with help.

As we are now well past the initial response time set forth by the USPTO in "Ex Parte Quayle" action mailed May 26, 2006 in the reissue application, we will need your response by September 22, 2006. If we have not heard from you by this date, we will assume that you are unable or unwilling to reply in the timeframe necessary to prosecute this case. In order to preserve rights, we will have to take other actions to respond to the USPTO in this matter and bring prosecution to a close.

Should you have questions or comments, please do not hesitate to contact Keith Moore, Intellectual Property Attorney at (775) 448-1174 or myself at (775) 448-1438 to discuss.

Very truly yours,

A handwritten signature in black ink, appearing to read "Kimberley A. DiMino", is written over the typed name.

Kimberley A. DiMino
Trademark and Legal Administration
Manager, Intellectual Property Department

/kad

Enclosures

cc: Keith Moore, Esq.

International Game Technology

9295 Prototype Drive
Reno, NV 89521-8986
775-448-7777

SENDER: COMPLETE THIS SECTION

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- Attach this card to the back of the mailpiece, or on the front if space permits.

1. Article Addressed to:

MR. BOB LUCIANO, JR.
BALLY TECHNOLOGIES
950 SANDHILL ROAD
RENO, NV 89521

2. Article Number

(Transfer from service label)

7004 1350 00037927 2606

PS Form 3811, February 2004

Domestic Return Receipt

COMPLETE THIS SECTION: ON DELIVERY

A. Signature

X

X. Carter☐ Agent☐ Addressee

B. Received by (Printed Name)

BALLY'S

C. Date of Delivery

*8-23-06*D. Is delivery address different from item 1? ☐ YesIf YES, enter delivery address below: ☒ No

3. Service Type

☒ Certified Mail☐ Express Mail☐ Registered☒ Return Receipt for Merchandise☐ Insured Mail☐ C.O.D.

4. Restricted Delivery? (Extra Fee)

☐ Yes

102595-02-M-1540

UNITED STATES POSTAL SERVICE RENO NV 895

24 AUG 2006 PM 3 T

First-Class Mail
Postage & Fees Paid
USPS
Permit No. G-10

• Sender: Please print your name, address, and ZIP+4 in this box •

KIMBERLEY DIMINO
INTELLECTUAL PROPERTY DEPARTMENT
IGT
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